

**REMARKS**

**Status of the claims:**

With the above amendments, claims 1 and 5 have been amended. No new matter has been added by way of the above amendments. Reconsideration is respectfully requested in light of the following remarks.

**Rejections under 35 USC §112, second paragraph**

Claims 1 and 5 are rejected under 35 USC §112, second paragraph as being indefinite. The Examiner asserts that it is unclear if the tread has the specified modulus E1 and modulus E2 in claim 1. Regarding claim 5, the Examiner asserts that it is unknown if two treads are being claimed. The Examiner has suggested claim amendments to obviate the above rejections. Applicants have amended the claims accordingly. Applicants believe that with the above amendments that the rejections have been obviated. Withdrawal of the rejection is warranted and respectfully requested.

**Rejections under 35 USC §103**

Claim 1 is rejected under 35 USC §103(a) as being unpatentable over JP '204 (JP 62-191204) in view of JP '209 (JP 07-061209) and JP '214 (JP 10-129214) and optionally further in

view of Uchida '885 (US Patent No. 6,374,885 or EP 1006007) or German '792 (DE Patent No. 3122792).

Claim 5 is rejected under 35 USC §103(a) as being unpatentable over JP '204 in view of JP '209 and JP '214 and optionally further in view of Uchida '885 or German '792 and further in view of JP '603 (JP 03-258603).

Applicants traverse.

**Removal of the Rejections over JP '204, JP '209, JP '214, Uchida '885 or EP 1006007, German '792, and JP '603**

Uchida '885 is not a prior art document under the provisions of 35 USC §103(c). Applicants herein confirm that the instant invention and Uchida '885 were commonly owned at the time of the later invention. Accordingly, Uchida '885 is not prior art. Please see MPEP §§ 706.02(1)-706.02(1)(3) and 2146.

Applicants, herein, submit a verified translation of the priority document of the instant invention, which removes EP 1006007 as prior art. Accordingly, EP 1006007 is also not prior art.

JP '204 describes using 5 to 60 parts by weight of staple fibers, JP '209 describes using 2 to 10 parts by weight of staple fibers and JP '214 describes that the amount of staple fibers preferably does not exceed 30 parts by weight. The Examiner asserts that 3 to 20 parts of staple fibers can easily

be compounded in JP '204. However, Applicants respectfully submit that the Examiner should keep in mind that the elastic modulus of a tread in which staple fibers are dispersed depends largely on the elastic modulus of the staple fiber itself.

In JP '209 and JP '214, organic fibers having extremely low elastic modulus in comparison to CF (carbon fibers) or GF (glass fibers) are used. JP '209 and JP '214 disclose adding a small amount of staple fibers, but this does not provide motivation for using a small amount of 3 to 20 parts by weight of CF or GF having extremely high elastic modulus as staple fibers.

Also, the Examiner asserts that the elastic modulus ratio element is descriptive of using a small amount of staple fibers. However, in Experiment 2 of the Declaration submitted on May 28, 2003, the elastic modulus ratio exceeds 4, even though the amount of GF was present at a small amount of 5 parts by weight. Thus, it should be apparent to those of ordinary skill in the art that the ratio  $E1/E2$  is largely influenced not only by the amount of GF but also by the orientation direction. Accordingly,  $1.1 \leq E1/E2 \leq 4$  is not satisfied merely by compounding a small amount of staple fibers (but it also is affected by the orientation).

In the present invention, a tire excellent in braking performance on ice and abrasion resistance can only be obtained by fulfilling the elements of type, length, diameter, amount and

elastic modulus ratio of the staple fiber at the same time. Even in the case where the elements of the present invention regarding the type, length, diameter and amount of staple fibers are simply combined with the descriptions of the prior art, a tire excellent in braking performance on ice and abrasion resistance cannot be obtained, unless the element of elastic modulus ratio is satisfied. This combination of features is neither recognized nor suggested by any of the recited art. Please again note that if one of these features is not present, the tire is inferior in either braking performance or abrasion resistance. Please note the declaration filed May 28, 2003. For this reason alone, the rejection is inapposite. Withdrawal of the rejection is warranted and respectfully requested.

Applicants also respectfully submit the following comments regarding the declaration filed May 28, 2003. Regarding claim 5, the Examiner asserts that reasonable evidence has not been provided that indicates that the same results can be obtained even if a tread is not obtained by rolling with a calendar roll and repeatedly folding it.

Applicants, herein, file the attached 37 CFR §1.132 declaration, that shows even when the tread is not obtained by rolling with a calendar roll and repeatedly folding it, a tread can satisfy the elements of the claims. This results in a tire excellent in braking performance on ice and abrasion resistance.

Thus, for all of the above reasons, Applicants submit that a proper obviousness rejection has not been made by any combination of JP '204, JP '209, JP '214, Uchida '885, EP 1006007, German '792, and JP '603. Accordingly, withdrawal of the rejections is warranted and respectfully requested.

With the above remarks and amendments, Applicants believe that the claims, as they now stand, define patentable subject matter such that passage of the instant invention to allowance is warranted. A Notice to that effect is earnestly solicited.

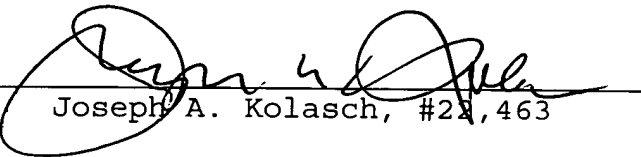
If any questions remain regarding the above matters, please contact Applicant's representative, T. Benjamin Schroeder (Reg. No. 50,990), in the Washington metropolitan area at the phone number listed below.

Pursuant to the provisions of 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for one (1) month extension of time for filing a response in connection with the present application. The required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachments: A verified English translation of Japanese Patent Application No. 212129/1999

Declaration under 37 CFR § 1.132 by Mr. Akira Minagoshi with Figs. 1-4